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Paper No. 12
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Storage-All Inc.**

Serial No. 75/**701,938**

Mark Levy of Salzman & Levy for **Storage-All Inc.**

Susan C. Hayash, Trademark Examining Attorney, Law Office 110
(Chris A. F. Pedersen, Managing Attorney).

Before **Seeherman, Hohein and Holtzman**, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Storage-All Inc. has filed an application to register
the mark "STORAGE-ALL INC." for "storage space rental services."¹

Registration has been finally refused under Section
2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground
that applicant's mark, when applied to its services, so

¹ Ser. No. 75/701,938, filed on May 10, 1999, which alleges a date of
first use anywhere of July 15, 1988 and a date of first use in
commerce of November 11, 1989. The term "INC." is disclaimed.

resembles the following marks, which are registered for the services of "leasing of storage space" and are owned by the same registrant, as to be likely to cause confusion, mistake or deception: (i) the mark "STOR-ALL SELF-STORAGE RENTALS" and design,² as illustrated below,



and (ii) the mark "STOR-ALL SYSTEMS" and design,³ as reproduced below.



Applicant has appealed. Briefs have been filed,⁴ but an oral hearing was not requested. We affirm the refusal to register.

² Reg. No. 1,338,398, issued on May 28, 1985, which sets forth a date of first use of July 1983 and a date of first use in commerce of September 1983; combined affidavit §§8 and 15. The words "SELF-STORAGE RENTALS" are disclaimed.

³ Reg. No. 1,054,556, issued on December 14, 1976, which sets forth a date of first use anywhere of August 14, 1967 and a date of first use in commerce of May 23, 1968; renewed. The word "SYSTEMS" is disclaimed and the mark is lined for the colors brown and orange.

⁴ Applicant, as Exhibits B through E to its brief, has submitted as additional evidence (i) copies of printouts from various third-party websites for, *inter alia*, supporting hooks and self-storage services, and (ii) the affidavit of its president, Ronald DiLorenzo, Sr. The

The determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity of the goods and/or services and the similarity of the marks.⁵

Turning first to consideration of the respective services, we concur with the Examining Attorney that, as identified, applicant's "storage space rental services" and registrant's "leasing of storage space" services "are virtually

Examining Attorney, in her brief, has objected to the submission of such evidence as being "untimely and improper [inasmuch] as it was not previously provided to the trademark examining attorney." Trademark Rule 2.142(d) provides in relevant part that the Board will ordinarily not consider additional evidence submitted after an appeal is filed. In view thereof, and since, with the exception of a portion of evidence attached to applicant's brief as Exhibit B (such portion consisting of a copy of a third-party registration for the mark "STOR-ALL" for "supporting hooks" which applicant previously made of record with its request for reconsideration), the additional evidence submitted by applicant is indeed untimely and improper, the Examining Attorney's objection is sustained to the extent that the copies of printouts from various third-party websites and the affidavit of applicant's president will not be given further consideration. Nonetheless, it is pointed out that even if the additional evidence were to be considered to be of record, consideration thereof would make no difference in the outcome of this appeal.

⁵ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and/or services] and differences in the marks."

the same," "if not identical," in legal contemplation.⁶ It is settled, as the Examining Attorney correctly notes in this regard, that the issue of likelihood of confusion must be determined on the basis of the services as they are set forth in the involved application and cited registration. See, e.g., CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Thus, where the services in the application at issue and in the

⁶ As support therefor, the Examining Attorney in her brief has requested that "the Board take judicial notice of the definitions of Leasing, Rental, and Rent attached as Exhibit B" since such definitions show that the respective storage services "both allow an individual to use or occupy property under terms of a contract for the exchange of money." Specifically, The American Heritage Dictionary of the English Language (3rd ed. 1992) in pertinent part defines "leasing" as a verb meaning "1. To grant use or occupation of under the terms of a contract," with "lease," we also note, being defined thereby as a noun signifying "1. a. A contract granting use or occupation of property during a specified period in exchange for a specified rent." The same dictionary in relevant part lists "rental" as a noun meaning "1. An amount paid out or taken in as rent. 2. Property available for renting: *summer rentals by the beach*" and as an adjective meaning "[o]f, relating to, or available for rent: *rental income; rental properties*," while "rent" is set forth as a noun connoting "1. a. Payment, usually of an amount fixed by contract, made by a tenant at specified intervals in return for the right to occupy or use the property of another. b. A similar payment made for the use of a facility, equipment, or service provided by another." Inasmuch as the Board may properly take judicial notice of dictionary definitions, we grant the Examining Attorney's request and have considered the above definitions. See, e.g., Hancock v. American Steel & Wire Co. of New Jersey, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and Marcal Paper Mills, Inc. v. American Can Co., 212 USPQ 852, 860 (TTAB 1981) at n. 7.

cited registration are broadly described as to their nature and type, it is presumed in each instance that in scope the application and registration encompass not only all services of the nature and type described therein, but that the identified services move in all channels of trade which would be normal for such services and that they would be purchased by all potential buyers thereof. See, e.g., In re Elbaum, 211 USPQ 639, 640 (TTAB 1981).

In consequence thereof, applicant's attempt to distinguish the respective services, based upon arguments relating to unspecified differences in "factors such as security, temperature controlled storage spaces, location, price, and size of the storage facility," is without merit. Likewise, in the absence of any restrictions or limitations which are set forth in the recitations of the respective services, applicant's contentions that differences exist in the channels of trade for such services and the levels of purchaser sophistication are unavailing. Instead, applicant's storage space rental services and registrant's leasing of storage space services must be considered to be legally identical and, accordingly, such services would be rendered through the same channels of trade and to identical classes of purchasers, including those who are ordinary and relatively unsophisticated

consumers. The rendering of the respective services, under the same or substantially similar marks, would therefore be likely to cause confusion as to source or sponsorship.

As to the marks at issue, applicant maintains that its mark "is visually distinct" from both of registrant's marks, given the design elements and descriptive matter included in the latter. Applicant also asserts, in view thereof, that "the marks, when compared side-by-side in their entireties, are different in ... sound, connotation, and commercial impression." However, as the Examining Attorney correctly points out, a side-by-side comparison is not the proper test to be used in determining the issue of likelihood of confusion inasmuch as it is not the ordinary way that customers will be exposed to the marks. Instead, it is the similarity of the general overall commercial impression engendered by the marks which must determine, due to the fallibility of memory and the concomitant lack of perfect recall, whether confusion as to source or sponsorship is likely. The proper emphasis is accordingly on the recollection of the average purchaser, who normally retains a general rather than a specific impression of marks. See, e.g., *Envirotech Corp. v. Solaron Corp.*, 211 USPQ 724, 733 (TTAB 1981); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); and *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973).

Moreover, while marks must be considered in their entireties, including any descriptive matter or design element, our principal reviewing court has indicated that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, according to the court, "that a particular feature is descriptive ... with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark" Id.

In the present case, when the respective marks are considered in their entireties, it is plain that they are not only highly similar in appearance and sound but are substantially the same in connotation and commercial impression. As to appearance, it must be kept in mind that because applicant seeks registration of its "STORAGE-ALL INC." mark in typed form, the display thereof could include the same stylized manner of lettering as that utilized by registrant for the term "STOR-ALL" in its "STOR-ALL SELF-STORAGE RENTALS" and design mark and its "STOR-ALL SYSTEMS" and design mark. See, e.g., Phillips

Petroleum Co. v. C. J. Webb, Inc. 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) [a mark registered in typed format is not limited to the depiction thereof in any special form]; and INB National Bank v. Metrohost Inc., 22 USPQ2d 1585, 1588 (TTAB 1992) ["[a]s the *Phillips Petroleum* case makes clear, when [an] applicant seeks a typed or block letter registration of its word mark, then the Board must consider all reasonable manners in which ... [the word] could be depicted"].

Clearly, in each of registrant's marks, the term "STOR-ALL" forms the dominant and distinguishing element thereof since it is not only the most visually prominent element therein, due to its size and stylized manner of display, but the words "SELF-STORAGE RENTALS" and "SYSTEMS," as well as the design feature consisting of images of a self-storage facility, are descriptive of respondent's storage space leasing services and thus constitute subordinate matter. Purchasers and prospective customers for such services, therefore, generally would tend to refer to respondent's services by the term "STOR-ALL." Such term both looks and sounds highly similar to the term "STORAGE-ALL," which forms the dominant and distinguishing element in applicant's "STORAGE-ALL INC." mark, given that the term "INC." therein is simply an entity designation and would be so regarded by consumers and potential buyers of applicant's storage space rental services.

Furthermore, the record contains a definition from The American Heritage Dictionary of the English Language (3rd ed. 1992) which lists "stor." as an abbreviation of the word "storage." Consequently, not only do the dominant and distinguishing terms "STOR-ALL" and "STORAGE-ALL" in the marks at issue share substantially the same connotation, but as the Examining Attorney points out, because such terms "could be used interchangeably," the respective marks substantially "create the same overall commercial impression." Thus, and notwithstanding that such marks are highly suggestive of storage space rental or leasing services, in their entireties applicant's "STORAGE-ALL INC." mark and registrant's "STOR-ALL SELF-STORAGE RENTALS" and design mark and its "STOR-ALL SYSTEMS" and design mark are so highly similar in appearance and sound and substantially identical in connotation and commercial impression that, when used in connection with legally identical services, confusion is likely to occur.

Applicant further argues, however, that the conditions of sale for storage space rental or leasing services are such that even ordinary consumers must be treated as sophisticated and discriminating purchasers who will be expected to exercise a high degree of care in their selection of a self-storage facility and would know the firm from which they are renting or leasing storage space. According to applicant:

[I]t is unlikely that there would be any confusion as to source of the services. A customer is fully informed and carefully compares storage companies before making a decision with regard to storing. A storage facility provides services unlike any other. A customer places valuable possessions, confidential information, business papers, or personal property (e.g., cars, RVs, boats, furniture) in these facilities. It is unlikely that a customer is going to make a spontaneous decision in choosing a storage facility to these or other valuable items.

....

Furthermore, before one rents a storage facility, a contract is signed by both lessor and lessee. Customers know exactly with whom they are contracting. There is personal interaction between a customer and a storage facility. Even if a customer was confused as to whether he/she was dealing with Appellant or ... Registrants [sic], he/she would have the opportunity to inquire further to determine who is providing the service.

Storage space is not purchased casually. In fact it can become quite expensive. Price increases as the amount of space required increases and duration of use increases. This further supports Appellant's assertion that it is unlikely that purchasers would be confused between Appellant's and Registrants' [sic] services.

While perhaps in some instances the rental or leasing of storage space can rise to an expensive level, it is also the case, as applicant acknowledges in its brief, that such a rental "may only be for a short period of time and involve minimal expense." Nevertheless, even assuming that storage space is

purchased only after careful consideration, it is well settled, as the Examining Attorney correctly notes, that the fact that consumers may exercise deliberation in choosing the respective services "does not necessarily preclude their mistaking one [service mark or] trademark for another" or that they otherwise are entirely immune from confusion as to source or sponsorship. *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962). See also *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988); and *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983).

Applicant additionally contends that, inasmuch as it "is not aware of any actual confusion between Appellant's and Registrants' [sic] marks" and because the Examining Attorney has not "provided any evidence of actual confusion," "the absence of evidence of actual confusion" favors applicant. However, absence of evidence of actual confusion is clearly not evidence of the absence of actual confusion. While, of course, evidence of the absence of any instances of actual confusion over a significant period of time is a *du Pont* factor which is indicative of no likelihood of confusion, it is a meaningful factor only where the record demonstrates appreciable and continuous use by applicant of its mark in the same markets as those served by registrant under its mark(s). See, e.g., *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB

1992). In particular, there must be evidence showing that there has been an opportunity for incidents of actual confusion to occur. See, e.g., *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000). Here, there is simply no evidence in the record, such as information concerning details of the nature and extent of the sales and marketing activities of applicant and registrant under their respective marks, from which it could be concluded that the asserted absence of any instances of actual confusion is indeed a mitigating factor. Compare *In re General Motors Corp.*, 23 USPQ2d 1465, 1470-71 (TTAB 1992).

Finally, applicant points to the fact that, with its request for reconsideration of the final refusal, it made of record copies of two third-party registrations, owned by different registrants, which are for the mark "STOR-ALL" for "supporting hooks"⁷ and the mark "STOR-ALL" for "corrugated boxes".⁸ According to applicant, "[t]hese marks are used on products that are generally associated with storage facilities (storage boxes and hooks)," yet such marks co-exist on the register with the cited registrant's marks. Specifically, applicant maintains that:

⁷ Reg. No. 1,131,632, issued on March 11, 1980, which sets forth a date of first use anywhere and in commerce of August 1975; renewed.

⁸ Reg. No. 2,218,234, issued on January 19, 1999, which sets forth a date of first use anywhere and in commerce of January 1, 1964.

Some facilities sell corrugated boxes for storage purposes and even use hooks within the storage space itself. It is highly likely that one would associate the registered marks with one another before he/she associated Appellant's and Registrants' [sic] marks.

However, as the Examining Attorney has correctly pointed out, the co-existence of the third-party registrations with the cited registrations "do[es] not justify registration of yet another confusing mark." As stated in *AMF Incorporated v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973):

[L]ittle weight is to be given such registrations in evaluating whether there is likelihood of confusion. The existence of these registration is not evidence of what happens in the market place or that customers are familiar with them nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake or to deceive.

Moreover, and in any event, the third-party registrations and the cited registrations are for different goods and services, while applicant's services and those in the cited registrations, as noted previously, are considered to be legally identical.

We accordingly conclude that consumers and potential customers, who are familiar or acquainted with registrant's "STOR-ALL SELF-STORAGE RENTALS" and design mark and its "STOR-ALL SYSTEMS" and design mark for, in each instance, the services

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of "leasing of storage space," would be likely to believe, upon encountering applicant's "STORAGE-ALL INC." for "storage space rental services," that such legally identical services emanate from, or are sponsored by or associated with, the same source.

Decision: The refusal under Section 2(d) is affirmed.